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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,872	01/21/2004	Jeffrey Robert Fergusson	114663-008	3145

7590 03/17/2005

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EXAMINER
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MAYO, TARA L

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/761,872

Applicant(s)

FERGUSON, JEFFREY ROBERT

Examiner

Tara L. Mayo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-13, 17 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-13, 17, 22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/07/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The prior objection to the Drawings has been overcome by the response filed 07 December 2004 wherein Applicant amended the Specification to include the previously omitted reference numeral.

### *Specification*

2. The prior objection to the Abstract has been overcome by the response filed 07 December 2004.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 15 and 22 through 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 15 are both dependent upon canceled claims.

Claim 22 recites the limitation "said parts" on line line 4. There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13, 17 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbst (U.S. Patent No. 3,978,674).

Herbst '674, as seen in Figures 1 through 5, shows a two-part rock bolt anchor adapted to be fitted to a tendon of a rock bolt, said anchor comprising:

with regard to claims 13 and 22,

a body (4) engageable with grout (16) into which said bolt is embedded, and having two parts (4' and 4'') shaped to be clamped together over said tendon;

with regard to claim 17,

wherein said two parts are substantially identical; and

with regard to claim 22,

said anchor being shaped to be press fitted to said tendon.

With regard to claims 13 and 22, the claimed limitation of the tendon moving through the parts in yielding is anticipated by Herbst '674 because the device is capable of performing in the manner claimed while in use.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 through 3, 10 through 12, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie (U.S. Patent No. 5,586,839A) in view of Parker (U.S. Patent No. 4,305,687).

Gillespie '839, as seen in Figures 12 and 13, shows a yielding grouted rock bolt to control the movement of unstable rock strata into which the bolt is installed, said bolt comprising:

with regard to claim 1,

an elongate tendon (12 and 18, in combination); and

a grout engaging anchor (64) fitted to said tendon and thereby at least partially deforming the same;

whereby in yielding said tendon passes through said anchor and is worked thereby;

with regard to claim 3,

wherein said tendon is formed from metal;

with regard to claim 10,

wherein said tendon comprises a multi-strand cable;

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with regard to claim 11,

wherein said tendon comprises a bar (18); and

with regard to claim 12,

further comprising a plurality of said grout engaging anchors.

Gillespie '839 shows all of the features of the claimed invention with the exception(s) of:

with regard to claim 1,

a portion of said tendon having a grout slippage means;

with regard to claims 2 and 23,

the grout slippage means comprising a tube (having an interior sized to receive the tendon);

with regard to claim 3,

the tube being made from plastic material; and

with regard to claim 24,

the tube being crushed to press fit the tube onto the tendon.

Parker '687, as seen in Figure 7, shows a rock bolt (73) comprising an anchor (various embodiments) and expressly teaches the use of plastic for promoting slight slippage in grout as desired for enhancing the compressive strength of the grout (col. 11, lines 35 through 62).

With regard to claims 1 through 3 and 23, it would have been obvious to one having ordinary skill in the art of earth control at the time of invention to modify the device shown by Gillespie '839 such that it would include a plastic tube as taught to be desirable by Parker '687 for promoting slippage and increasing the compressive strength of the grout in the rock strata.

With regard to claim 24, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

9. Claims 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie (U.S. Patent No. 5,586,839 A) in view of Parker (U.S. Patent No. 4,305,687) as applied to claim 1 above, and further in view of Herbst (U.S. Patent No. 3,978,674).

Gillespie '839 as modified above by Parker '687 further discloses:

with regard to claim 4,

said anchor body engageable with said grout.

Gillespie '839 as modified above by Parker '687 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claim 4,

the anchor being formed in two parts which are clamped together over the tendon portion to fit the anchor thereto;

with regard to claim 8,

the two parts being substantially identical; and

with regard to claim 9,

the parts being maintained clamped together by keeper rings shaped to mate with the parts.

Herbst '674, as seen in Figures 1 through 5, shows an anchoring device (4) for attachment to a rock bolt (2), the anchoring device having a body formed in two substantially identical parts (4' and 4'') which are clamped together by a keeper ring (9) shaped to mate with said parts, wherein said parts include a plurality of complementary protrusions (11) and recesses (the void of extension 11), at least one pair of opposed protrusions forming a corresponding pinch point.

With regard to claims 4, 8 and 9, it would have been obvious to one having ordinary skill in the art of earth control at the time the invention was made to modify the device shown by the combination of Gillespie '839 and Parker '687 such that the anchor device would be formed in two parts as taught by Herbst '674. The motivation would have been for ease of assembly.

### *Double Patenting*

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v.*



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*Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 1 through 24 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 through 24 of copending Application No. 10/601,024. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

#### *Response to Arguments*

12. Applicant's arguments filed 07 December 2004 have been fully considered but they are not persuasive.

In response to Applicant's statements regarding Herbst '674, it is noted that the claimed device teaches all of the features of the claimed invention and is capable of meeting the functional limitation of moving through the parts in yielding and not necessarily to point of failure as argued by Applicant.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is the express teaching by Parker '687 for the desirability of slippage.

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TLM

07 March 2005

